

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TAKAHARU KITADA

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Appeal No. 2006-3239  
Application No. 09/665,667

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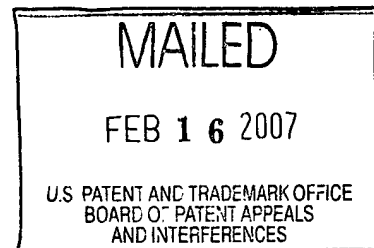
ON BRIEF

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Before BARRY, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL



This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-20, which are all the claims in the application.

We affirm.

### BACKGROUND

The invention relates to an information processing system and method whereby an information providing medium is inconspicuously attached to the entity.

Representative claim 1 is reproduced below.

1. An information processing system comprising:
  - an information providing medium that stores information in an electromagnetic or optical manner, the information providing medium being attached to an entity in order to provide information associated with the entity;
  - a hand held terminal device having an information read function for reading said information from said information providing medium in an electromagnetic or optical manner and recording the information therein; and
  - an information processing unit for retrieving said information recorded in said hand held terminal device and processing the information therein;
- wherein said information providing medium is inconspicuously attached to the entity.

The examiner relies on the following references:

Gallagher, III et al. (Gallagher)	US 5,959,531	Sep. 28, 1999
Storch et al. (Storch)	US 5,367,148	Nov. 22, 1994
Reymond	US 5,898,370	Apr. 27, 1999
Watada	US 6,012,641	Jan. 11, 2000
Walsh et al. (Walsh)	US 6,089,456	Jul. 18, 2000
Zembitski	US 6,193,160 B1	Feb. 27, 2001

Claims 1, 2, 6, 10, 15, 16, 18, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zembitski and Reymond.

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Claims 3 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, and Storch.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, Gallagher, and Watada.

Claims 5, 7, and 11-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, and Walsh.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walsh and Reymond.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, and Storch.

We refer to the Final Rejection (mailed Dec. 12, 2002) and the Examiner's Answer (mailed Nov. 2, 2004) for a statement of the examiner's position and to the Brief (filed Sep. 22, 2003) and the Reply Brief (filed Dec. 17, 2004) for appellant's position with respect to the claims which stand rejected.

#### OPINION

In response to the rejection of claim 1 over Zembitski and Reymond, appellant submits that a "fundamental difference" between the claimed invention and Zembitski is that Zembitski merely reads the bar code, and associates the scanned data with information in a database. (Brief at 8.) Appellant does not, however, point to any

language in the claim that might distinguish over reading a bar code and associating the scanned data with information in a database. Nor do we find any such language.

Appellant next argues that Zimbitski teaches using a scanner that needs to have the label knowingly in its line of sight. To “hide” the label in Zimbitski, according to appellant, would make Zimbitski inoperative. (Id.) Appellant, again, neglects to point out any claimed limitations that might correspond to the argument. Claim 1, however, ends with the recitation “wherein said information providing medium is inconspicuously attached to the entity.”

According to appellant’s Brief (at 3-4), the recitation is supported by the specification at page 3, line 22 to page 4, line 9 and page 12, line 19 to page 13, line 15. The only description of what might be considered “inconspicuously attached” in the identified sections appears at the final paragraph of page 12. The specification describes therein that in the case that the system is used to discriminate whether the entity 2 (Fig. 1) is genuine or counterfeit, “the form in which the information providing medium 1 is embedded in the object.” Accordingly, only “an authorized checker or a specific information user can grasp its mount location.” We note, further, that a more detailed description of the embodiment appears at pages 74 and 75 of the specification. Figure 19 depicts “information providing electronic part” 11, whereby item information is read in an electromagnetic manner, using information reading display 12.

Clearly, an information providing medium that stores information to be read in an electromagnetic manner can be embedded in an object, as depicted in instant Figure

19. Such an embedded medium may be considered, fairly, as “inconspicuously attached.” Appellant does not, however, point to any express description in the disclosure whereby an information providing medium capable of being read in an optical manner might be considered “inconspicuously attached.” We conclude that the claim 1 recitation of wherein the medium is inconspicuously attached, at least as it applies to the alternative that the medium stores information that may be read in an optical manner, does not require having the medium always aligned with an optical reader, as appellant seems to argue. We hold, in fact, that the claim 1 recitation cannot distinguish over a bar code that is attached to an article, as described by Zembitski. A bar code that covers only a small portion of a package, consistent with Figures 6(a) through 6(c) of Zembitski, may fairly be considered “inconspicuously attached,” for all that the “wherein” clause of claim 1 requires.

Independent claim 10, which recites “inconspicuously attaching” an information providing medium that stores information in an electromagnetic “or optical” manner to an article or material, likewise cannot distinguish over the bar code system described by Zembitski. Appellant does not argue any of the dependent claims separately. Not being persuaded of error in the rejection of any of the claims, we sustain the rejection of claims 1, 2, 6, 10, 15, 16, 18, and 19 under 35 U.S.C. § 103 as being unpatentable over Zembitski and Reymond.

Representative claim 3 recites that the information processing unit of claim 1 is adapted to discriminate whether the information read from the hand held terminal is

“genuiness [sic] or counterfeit.” Appellant submits that because Storch requires two separate tags, one on the outside and one on the inside of a product, at least one tag must be in plain view and thus cannot be “inconspicuously attached” as recited in independent claim 1.

As we have indicated in association with instant claim 1, we do not consider the recitation “inconspicuously attached” to require that an (optical) information providing medium never be in plain view. Moreover, Storch does not require that one tag be on the inside of a product; nor does Storch require that an information providing medium be in plain view. Storch describes embodiments suitable for product authentication in which a bar code may be readable by an optical scanner, yet invisible to the human eye, or hidden by virtue of the code being invisible or transparent to humans and placed over another, visible, bar code. See Storch col. 22, l. 55 - col. 24, l. 4. It would seem that such embodiments would have to meet even appellant’s unarticulated definition of “inconspicuously attached.”

We thus sustain the rejection of claims 3 and 17 under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, and Storch. We also sustain the rejection of claim 4 under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, Gallagher, and Watada and the rejection of claims 5, 7, and 11-14 under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, and Walsh, as the claims are not separately argued. Appellant has thus not shown error in the rejection of representative claims 4 and 7. See 37 CFR § 1.192(c)(7) (2003); see also In re

McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (“If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.”).

Appellant’s argument in support of representative claim 8 is based on the supposition, that we have previously considered, that bar code media cannot be “inconspicuously attached” to an entity. We again find the position to be untenable. Moreover, the artisan knew, as evidenced by Storch, there was no requirement that bar code information be visible to human observers. Appellant’s position in support of claim 20 rests on the notion that bar code media cannot be “inconspicuously attached,” and fails to address the embodiments of Storch that we have noted in relation to instant claim 3. We therefore sustain the rejection of claims 8 and 9 under 35 U.S.C. § 103 as being unpatentable over Walsh and Reymond, and the rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over Zembitski, Reymond, and Storch.

#### CONCLUSION

The rejection of claims 1-20 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

~~LANCE LEONARD BARRY~~  
~~Administrative Patent Judge~~

**HOWARD B. BLANKENSHIP**  
Administrative Patent Judge

**MAHSHID D. SAADAT**  
Administrative Patent Judge

BOARD OF PATENT  
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RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036